

REMARKS

This is a full and timely response to the non-final Official Action mailed 15 October 2004. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, the claims 1 and 2 have been amended. Additionally, new claims 45-49 have been added and claim 31 has been cancelled. Claims 3 and 6 were cancelled previously, and claims 11-27 were withdrawn previously under a Restriction Requirement. Thus, claims 1, 2, 4, 5, 7-10 and 32-49 are currently pending for the Examiner's consideration.

In the outstanding Office Action, the Examiner allowed claims 32-40. Applicant wishes to thank the Examiner for the allowance of these claims.

With regard to the prior art, the outstanding Office Action rejected claims 1, 2, 4, 5 and 31 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 6,166,919 to Nicolici et al. ("Nicolici"). Claim 7 was rejected as being unpatentable under 35 U.S.C. § 103(a) over the teachings of Nicolici taken alone. For at least the following reasons, these rejections are respectfully traversed.

Claim 1 as amended herein recites:

A protective cover for a pin connector of a backplane, said cover comprising:
at least one connector having receptacles for receiving pins of a pin connector of a backplane; and
a planar member extending from said at least one connector,
wherein said at least one connector and said planar member are integrally formed of a single material.
(emphasis added).

Support for the amendments to claim 1, can be found, for example, in paragraph 0038 of Applicant's specification as originally filed. In contrast, Nicolici fails to teach or suggest the claimed protective cover that includes at least one connector and a planar member integrally formed of a single material. Consequently, Nicolici does not teach or suggest all the features of claim 1.

The recitations of amended claim 1 are significant because Nicolici is teaching a functioning electronic device with socket connectors (106) that are connected to a printed circuit board (100) to electrically interconnect the circuit board (100) with a backplane. Consequently, one of skill in the art would never consider forming the printed circuit board (100) and the socket connectors (106) from a single material.

In contrast, Applicant is claiming a cover for protecting the pins of a backplane. The cover need not include any electrical connections of any kind. Thus, the cover claimed by Applicant can profitably be formed from a single material as an integrated member. The material can be a purely non-conductive material, for example, plastic. In contrast, Nicolici fails to teach or suggest the claimed protective cover that includes at least one connector and a planar member integrally formed of a single material.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Because Nicolici fails to teach or suggest all the features of claim 1, the rejection of claims 1, 2, 5 and 7 should be reconsidered and withdrawn.

Claims 8-10 and 41-44 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Nicolici and U.S. Patent No. 4,197,945 to Sherwood ("Sherwood"). For at least the following reasons, this rejection is respectfully traversed.

Claim 8 recites:

A protective cover for a pin connector of a backplane, said cover comprising:
at least one connector having receptacles for receiving pins of a pin connector of a backplane;
a handle extending from said at least one connector for installing or removing said protective cover; and
clips extending from said cover for engaging a side of said pin connector and clipping said cover to said pin connector of a backplane.
(emphasis added)

Claim 41 similarly recites:

A protective cover for a pin connector of a backplane, said cover comprising:
means for receiving and protecting individual pins of a pin connector of a backplane;
a handle for installing or removing said protective cover, said handle extending from said means for receiving and protecting; and
securing means extending from said cover for securing said cover over said pins, wherein said securing means engage said pin connector of said backplane.
(emphasis added).

In contrast, Nicolici fails to teach or suggest the claimed clips or securing means. Consequently, the Office Action cites to Sherwood, seeking to combine the teachings of Nicolici with those of Sherwood.

Sherwood teaches an apparatus (17) for enclosing pins (11) of a connector. The apparatus (17) has "parallel flanges" (23) connected by a "hinge" (17). (*See* Sherwood, abstract). As shown in Fig. 4 of Sherwood, a force must be applied to pinch together upper portions (19) of the flanges (23) to operate the hinge (17) and engage or release the apparatus (17).

Applicant respectfully submits that one of skill in the art would not consider combining the teachings of Nicolici and Sherwood as proposed by the recent Office Action.

The Nicolici device includes connectors (106) on a circuit board (100). A filler module (10) is connected to and extends above the circuit board (100). Consequently, if the flanges (23) and hinge (21) of Sherwood were added to the module of Nicolici, it would not be possible to operate the hinge (21) to engage and disengage the module because operation of the hinge would be obstructed by the presence of the circuit board and filler module.

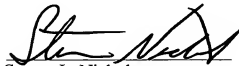
Therefore, one of skill in the art would not have been lead to combine the teachings of Nicolici and Sherwood as proposed by the Office Action. "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." M.P.E.P. § 2143.01. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992)." M.P.E.P. § 2143.01 (emphasis added).

Therefore, for at least this reason, the rejection of claims 8-10 and 41-44 based on the combination of Nicolici and Sherwood should be reconsidered and withdrawn. Notice to that effect is respectfully requested.

The newly added claims, claims 45-49, are similar to allowed claim 32 and are thought to be patentable over the prior art of record for at least the same reasons as allowed claim 32. Examination and allowance of new claims 45-49 is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,


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